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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,523	08/07/2001	Joseph P. Tutewohl	604-3	1763

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EXAMINER

KILKENNY, TODD J

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 08/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,523

Applicant(s)

TUTEWOHL, JOSEPH P.

Examiner

Todd J. Kilkenney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: In the first sentence of the specification, "serial number 09/515,541" should be corrected to – serial number 09/615,541 --.

Appropriate correction is required.

Claim Objections

2. Claim 17 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitation of claim 17 is already present in independent claim 15.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 defines a combination laminating tool having a roller with braking means supported at one end of a handle. It is unclear how this is a "combination" tool, as said

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combination tool as defined in applicant's specification includes a roller one on end of a handle in combination with a second component.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1 – 5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 7 and 11 of U.S. Patent No. 5,725,727 in view of Baril (US 4,196,491). Claim 1 of US Patent 5,725,727 discloses a combination laminating tool having a handle and a freely-rotatable roller supported at the first end of the handle. As to the braking means limitation provided in the current application, such would have been obvious to one of ordinary skill in the art at the time of the invention in view of the teaching to Baril, as providing locking means to a handheld roller is disclosed to provide beneficial rotational control of the free-wheeling roller when said roller is proximate edges and corners.

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7. Claims 12 – 17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 7 and 11 of U.S. Patent No. 5,725,727. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 12 of the present application, which requires male and female interlocking means and do not require pressing a button for release is encompassed by the releasable locking means of claim 7 of US 5,725,727. As to claims 14 and 15 of this application, claim 5 of US 5,725,727 suggests that both the roller and veneer presser are wider than the edge presser, but do not positively claim that the roller and veneer presser are approximately the same width. However, in view of the illustration of the combination tool (see Fig. 2) of US 5,725,727, one of ordinary skill in the art would have found obvious employing a veneer presser of approximately the same width as the roller.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Baril (US 4,196,491).

Baril teaches a paint roller comprising an elongated handle having two ends with a freely rotatable roller supported on one end thereof said roller also having locking

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means for interrupting the rotation of the cylindrical roller. Said locking means comprising a locking control on the handle and when instigated prevent the roller from rolling in the conventional free-wheeling manner (Col. 1, lines 53 – 59).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dizon (US 5,445,704) in view of Baril (US 4,196,491).

Dizon teaches an applicator tool comprises a handle (12) with a first roller (32) at one end thereof and a second roller (34) and a trimmer guide (18) at said opposite end thereof. Dizon fails to suggest braking means for the roller (32).

As addressed above, Baril teaches a roller comprising an elongated handle having two ends with a freely rotatable roller supported on one end thereof said roller also having locking means for interrupting the rotation of the cylindrical roller. Said locking means comprising a locking control on the handle and when instigated prevent the roller from rolling in the conventional free-wheeling manner (Col. 1, lines 53 – 59). It would have been obvious to one of ordinary skill in the art at the time of the invention to include locking means for the roller (32) of Dizon, as such are known to be provided for

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rollers in applicator tools as suggested by Baril to offer control over the free wheeling rotation of the roller when employing the roller near edges and corners.

As to claim 2, the trimmer guide (18) of Dizon is interpreted in a reasonable manner as applicant's edge presser as such is supported by and extends from the elongated handle. It is unclear as to whether the trimmer guide is wedge shaped, however it would have been obvious to one of ordinary skill in the art at the time of the invention to make said guide trimmer wedge shaped as the edges of such guides capable of trimming are well known, official notice is taken, to be chamfered, wherein having chamfered edges would define a wedge shape.

12. Claims 3 - 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dizon (US 5,445,704) in view of Baril (US 4,196,491) as applied to claim 1 above, and further in view of Buck (US 4,335,483).

The second roller (34) of the applicator of Dizon is interpreted in a reasonable manner to read on applicant's claimed veneer presser. As to said presser being detachable, while diagrammed as an integral unit, Dizon suggests that a modular format may be employed, which allows the applicator to be assembled and disassembled (Col. 2, lines 28 – 30). Such a teaching implies said second roller (34; the veneer presser) is detachable from said first roller (32), however Dizon fails to positively suggest means for releasably attaching, including male and female interlocking means which do not require pressing a button for release.

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Buck discloses a combination tool having rollers on opposite sides of an elongated handle, wherein the rollers can be interconnected to form the combination tool or disassembled and manually held separately. Said means for interconnection include threaded end (25, male interlocking means) and a socket 16 (female, interlocking means). No button is employed to release the connection. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the threaded interconnection as disclosed by Buck to render the Dizon tool modular as is suggested, wherein the threaded connection provides a strong assembly connection which cannot be easily and mistakenly disconnected during use by accidental release of a pressure button.

As to claim 5, as diagrammed in the Figures of Dizon, the second roller (34) is approximately as wide as roller (32) and has a rounded working surface.

As to claim 6, Dizon teaches the opposite side of the handle (12) from the first freely-rotatable roller (32) comprises a roller (34) and trimmer guide (18) as previous addressed. In regard to the claim language, both roller (34) and guide (18) can reasonably be interpreted as applicant's "pressure tips" as they both are capable of providing pressure points for the applicator, and as there are two, said roller (34) and trimmer guide (18) read on applicant's "plurality of pressure tips". Furthermore, in view of Buck's teaching as applied above, both of said roller (34) and trimmer guide (18) are rendered obvious to be releasably attachable to said handle.

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13. Claims 7 - 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dizon (US 5,445,704) in view of Buck (US 4,335,483).

As discussed above, Dizon teaches an applicator tool comprising a handle (12) with a roller (32) at one end thereof and a second roller (34) and a trimmer guide (18) at said opposite end thereof. As to claim 7, the second roller (34) and trimmer guide (18) have differing shapes and can be reasonably interpreted as applicant's claimed "plurality of pressure tips". As to claims 9, 12 and 15, said second roller (34) can be reasonably interpreted as applicant's "veneer presser". As to the "plurality of pressure points" being detachable and said veneer presser likewise defined as being detachable, while diagrammed as an integral unit, Dizon suggests that a modular format may be employed, which allows the applicator to be assembled and disassembled (Col. 2, lines 28 – 30). Such a teaching implies said second roller (34) and said trimmer guide (18) are detachable from said handle, however Dizon fails to positively suggest means for releasably attaching, said means including male and female interlocking means which do not require pressing a button for release.

Buck discloses a combination tool having rollers on opposite sides of an elongated handle, wherein the rollers can be interconnected to form the combination tool or disassembled and manually held separately. Said means for interconnection include threaded end (25, male interlocking means) and a socket 16 (female, interlocking means). No button is employed to release the connection. It would have been obvious to one of ordinary skill in the art at the time of the invention to include threaded interconnection as disclosed by Buck to render the Dizon tool modular as is

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suggested, wherein the threaded connection provides a strong assembly connection which cannot be easily and mistakenly disconnected during use by accidental release of a pressure button or accident separation of a purely telescopic connection. Said threaded connection renders both of said roller (34) and trimmer guide (18) releasably attachable to said handle.

As to claims 8, 13 and 16, the trimmer guide (18) is reasonably interpreted as applicant's claimed edge presser. It is unclear as to whether the trimmer guide is wedge shaped, however it would have been obvious to one of ordinary skill in the art at the time of the invention to make said guide trimmer wedge shaped as the edges of said bars capable of trimming are well known, official notice taken, to be chamfered, wherein having chamfered edges would define a wedge shape.

As to claims 14, 15 and 17, as diagrammed in the Figures of Dizon, the second roller (34) is approximately as wide as roller (32) and has a rounded working surface.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Todd J. Kilkenny** whose telephone number is **(703) 305-6386**. The examiner can normally be reached on Mon - Fri (9 - 5).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on (703) 308-2058. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



TJK


Michael W. Ball
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